

From: [Trials](#)
To: [Joseph Milowic III](#); [Bregman, Dion M.](#); [White, Jason C.](#); [Sherwin, Scott D.](#); [Bernstein, Ph.D., David P.](#); [Metco-KleinTools-IPRs](#); [Jim Glass](#); [Brienne Straka](#); [Quincy Lu](#)
Cc: [Trials](#)
Subject: RE: IPR2024-01401 (U.S. Patent No. 11,794,952): Request for Leave to File Preliminary Reply
Date: Wednesday, January 29, 2025 4:55:56 PM

Counsel:

Petitioner's request for a preliminary reply addressing the issues identified below is *granted*. The preliminary reply is limited to five substantive pages filed within two calendar weeks of the issuance of this email. Patent Owner is permitted to file a preliminary sur-reply, limited to five substantive pages, filed within two calendar weeks of the filing of Petitioner's preliminary reply.

No other briefing is permitted, and the authorized briefing is limited to the issues identified below.

This email will be added to the record of this proceeding and may be cited for authorization for the additional briefing.

Regards,

Tina Lee
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Joseph Milowic III <josephmilowic@quinnemanuel.com>
Sent: Wednesday, January 29, 2025 4:11 PM
To: Trials <Trials@USPTO.GOV>
Cc: Bregman, Dion M. <dion.bregman@morganlewis.com>; White, Jason C. <jason.white@morganlewis.com>; Sherwin, Scott D. <scott.sherwin@morganlewis.com>; Bernstein, Ph.D., David P. <david.p.bernstein@morganlewis.com>; Metco-KleinTools-IPRs <Metco-KleinTools-IPRs@morganlewis.com>; Jim Glass <jimglass@quinnemanuel.com>; Brienne Straka <briennestraka@quinnemanuel.com>; Quincy Lu <quincylu@quinnemanuel.com>
Subject: IPR2024-01401 (U.S. Patent No. 11,794,952): Request for Leave to File Preliminary Reply

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Your Honors:

I am counsel for Petitioner in the above IPR. Petitioner seeks leave to submit a short supplemental brief (no more than five pages), to be due within two weeks of an Order granting this request, that responds to arguments raised in the Preliminary Response in the above proceeding. Specifically, the requested brief would respond to Patent Owner's arguments regarding discretionary denial under Section 325(d).

Petitioner is mindful of both the Board's prohibition against argumentative emails to *Trials* and of 37 CFR § 42.108(c), which requires a request for a reply to "make a showing of good cause." Good cause exists here because Petitioner could not have foreseen Patent Owner's argument that the two prior art references, Burchia and Metabowerke, were considered by the examiner during prosecution of the parent applications to the '952 Patent. Petitioner could not have foreseen this argument because an English translation of the Metabowerke reference was not submitted during any of the prosecutions, only an English abstract. With respect to Burchia, while the Petition noted its citation in an IDS in the prosecution of the '952 Patent, Petitioner could not have foreseen Patent Owner's argument that its citation in other patents was relevant.

Petitioner and Patent Owner conferred on January 27-28, 2025. Patent Owner opposes Petitioner's request. Patent Owner responded to Petitioner's request with the following, which Petitioner includes in its entirety (correcting obvious typos):

"Please note in the email to the Board after noting that Patent Owner opposes, that Patent Owner asked Petitioner to allow us to include a section responding to your improper inclusion of an argument to the Board in an email, but you refused. If not, we will respond to your email to the Board, in a separate email, attaching this email."

To the extent the Board wishes to hold a hearing on this request, the parties are available Monday, February 3 @ 2-4 pm ET, Wednesday, February 5 @ 1-3 pm ET, or Friday, February 7 @ 3-5 pm ET. The parties will revert with availability should the Board require additional time slots.

Respectfully submitted,

Joseph Milowic III

Joseph Milowic III | Director of Well-Being & Of Counsel | Quinn Emanuel Urquhart & Sullivan, LLP | 718.517.0132 (mobile)